

REMARKS

Claims 1-29 and 31-40 are pending in the present application. Claims 1, 14, 23, 27, 32, 36, and 38 are being amended. Support for these amendments can be found at least on page 8 lines 20-25 of the specification as originally filed. No new matter is being introduced by way of these amendments.

Claims 1-5 and 7-24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Keating (hereafter Keating), "The New Business of Giving." Peter Keating, Beverly Goodman. Money. New York: 1998. Vol. 27, Iss. 13; pg. 92, 3 pgs. in view of Charitable Gift Fund (hereafter CGF), "Charitable Gift Fund: Resource Center – Securities Donation Tool," <http://web.archive.org/web/20000229084733/www301.charitablegift.org/resource/calculator/index.shtml>.

Amended base Claim 1 now recites, "... an instant transfer of each selected asset such that valuation of each donor selected asset is defined as a function of donor selected timing of transfer" where the underlined text is a limitation added by way of amendment in the Claim Listing above.

Referring now to page 22, last paragraph of the Office Action, the Office Action states Applicants Claim 1 "...provides an automated system for the analysis and selection of donor's assets for the purposes of donating to charity." Applicants respectfully disagree.

Applicants respectfully submit that Applicants' invention not merely automates, but improves upon a series of previously manual steps in such a way as to generate an outcome that was not previously possible. In addition, Applicants' invention performs a step not previously accomplished manually, and thus is novel and an inventive method for gifting. When gifting, optimizing an overall value of a charitable gift (for both a donor and a recipient charity), time is of the essence. Applicants' invention allows for precise control of the entire contribution process in a way that is not possible by a series of manual steps. Such a contribution process is not possible via manual steps because the manual steps require a significant amount of time to be performed. To illustrate this point, Applicants are providing the following examples.

In one example, a Donor (with or without an advisor) evaluates existing stock portfolio and determines the most tax-optimal asset to give. This step generally takes the Donor between

one and eight hours. This same step takes Applicants' invention mere seconds because Applicants' invention provides the inventive feature of instant transfers. In another example, a brokerage firm transfers assets from the donor to a charity. In this example, transferring assets requires from four hours to three weeks. In contrast, Applicants' invention takes mere seconds because transfers are instant.

Further, while a donor can be diligent in transferring assets, the manual process makes it virtually impossible for the donor to control the process in a way that ensures the ability to give the exact dollar amount intended due to a time delay (e.g., the price changes during administration time). On the other hand, the speed and accuracy of Applicants' invention allows the donor to carry out the steps above in a timely manner because the ability to transfer instantly. Instantly transferring assets provides the desired outcome of giving an exact amount to charity in fulfillment of a pledge not more and not less than that amount. The cited references are not capable of providing this result. Further useful examples of Applicants' invention may be found in Applicants specification as originally filed on page 8 line 20 through page 9 line 4.

Applicants' instant transfers are important because prices in financial markets are volatile. By following the manual process the charity has no ability to control the final liquidation value of the gift to ensure it is equal to the donor's intended gift amount. This is true because financial markets are inherently volatile, so much so that even in a matter of seconds or minutes, prices can unfavorably change to prevent locking in an intended sales price. Even in the very best-case manual-step scenario, it would take hours for the asset to transfer to the charity's account and be liquidated. In those hours, the price of the security will likely be different from the value at the transfer request. Applicants' invention solves the problem of price fluctuation by synchronizing and controlling the entire gifting process to guarantee that:

- 1) The donor receives the precise tax value he expects;
- 2) The charity receives the exact dollar value (after liquidating the asset) the donor intends; and
- 3) The donor repurchases the asset at the desired repurchase price (equal to the tax receipt value).

Without Applicants' invention, the time sensitivity of the financial markets makes it humanly impossible to control the desired outcome above. Using Applicants' claimed feature of instant transfers, control of the desired outcome is possible. Instant transfers are not considered by the cited references. In this way, Applicants' invention is a novel and an inventive method for gifting.

Accordingly, neither Keating nor CGF, alone or in combination, teach or suggest Applicants' claimed invention ("*an instant transfer of each selected asset such that valuation of each donor selected asset is defined as a function of donor selected timing of transfer*") as recited in amended base Claim 1.

Independent claims 1, 14 and 23 have similar limitations and should also be allowable for at least the same reasons presented above.

Dependent Claims 2-5, 7-13 and 15-24 inherit these limitations from respective base claims. Thus, the § 103 rejection of Claims 1-5 and 7-24 as being unpatentable over Keating in view of CGF is believed to be overcome. Acceptance is respectfully requested.

Claim 6 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Keating in view of CGF and further in view of The Fidelity Charitable Gift Fund Program Circular (hereinafter Fidelity), found via the WayBack Machine,
<http://web.archive.org/web/20000123054942/www301charitablegift.org/establish/index>, 12/22/1999, specifically, note the link at the top of the page to the PDF document.

Fidelity, similar to Keating, does not teach or suggest the concept of instant transfers. Therefore, Fidelity, does not add to Keating and CGF the missing claim features of "*... an instant transfer of each selected asset such that valuation of each donor selected asset is defined as a function of donor selected timing of transfer*..." as claimed in amended base Claim 1.

Thus, no combination of Fidelity, Keating and/or CGF imply, suggest or make obvious the claimed process as claimed in base Claim 1. Claim 6 depends from base Claim 1 and thus inherit these claim limitations. Thus, the § 103 rejection of Claim 6 being unpatentable over Keating in view of CGF and in further view of Fidelity is believed to be overcome. Acceptance is respectfully requested.

Claims 25 and 26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Keating in view of CGF as applied to Claim 1 above, and further in view of "America's Charities

Selects DonorNet as Exclusive E-Commerce Provider.” Business Editors. Business Wire. New York: June 1, 1999. pg. 1. (hereafter Editors).

Editors does not teach or suggest the concept of instant transfers. Therefore, Editor, does not add to Keating and CGF the missing claim features of “*... electronically transferring the selected assets, instantly, as a gift to the receiving entity through the global computer network according to donor selected timing, such that the transfer of the selected assets from the donor investment portfolio to the receiving entity is accelerated...*” as claimed in amended base Claim 23. Claims 25 and 26 depend from base Claim 23 and thus inherit these claim limitations. Thus, the § 103 rejection of Claim 25 and 26 being unpatentable over Keating in view of CGF and in further view of Editors is believed to be overcome. Acceptance is respectfully requested.

Claims 27-31 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Merrell (“Tip of the Week: Give to Charity, not to the Taxman.” The Guardian (pre-1997 Fulltext). Manchester (UK): Sep 10, 1995, pg. 10.)

Merrell does not teach or suggest the concept of instant instructions to transfer money (e.g., issue a charity check). Therefore Merrill does not disclose the claimed feature of “*... issuing the charity check to the donor for future use at a desired time of the user making a charitable gift to the certain charity, the charity check at that time serving as instant instructions from the donor to the donor advised organization to electronically disburse funds to make the charitable gift to the certain charity...*” as claimed by amended base Claim 27. Claims 28-31 depend from base Claim 27 and thus inherit these claim limitations. Thus, the § 103 rejection of Claim 27-31 being unpatentable over Merrell is believed to be overcome. Acceptance is respectfully requested.

Claims 32-35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Anonymous (“How to Give More for Less.” Management Today. London: Aug 1998. pg. 76, 2 pgs.) hereafter Anonymous.

Anonymous does not teach or suggest the concept of instant transfer. Therefore Merrill does not disclose the claimed feature of “*using the charitable gifts defined in the employer benefits system, electronically providing an instant transfer pre-tax corresponding amounts of the employee waived income as gifts to at least one charity such that tax-efficient transfers of employee compensation to each charity result*” as claimed by amended base Claim 32. Claims

33-35 depend from base Claim 32 and thus inherit these claim limitations. Thus, the § 103 rejection of Claim 32-35 being unpatentable over Anonymous is believed to be overcome. Acceptance is respectfully requested.

Claims 36 and 37 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Drache ("Hedge Fund Gift Sparks Furor: North Star Investors' Offers Sends Charities Looking Advice," National Post. Don Mills, Ont.: Dec 7, 1998. pg. C.8.) hereafter Drache.

Drache does not consider the concept of instant transfer delivery. Accordingly, Drache cannot not imply, suggest or otherwise make obvious "*... electronically providing an instant transfer, as a gift, at least a part of the remaining units that represent the owner's unrealized gain to a receiving entity, the receiving entity including a charity . . .*" as claimed by base Claim 36. Claim 37 depends from base Claim 36 and thus inherit these claim limitations. Thus, the § 103 rejection of Claim 36-37 being unpatentable over Drache is believed to be overcome. Acceptance is respectfully requested.

Claims 38-40 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Halverson ("Make gifts grow before they go to charity." Christian Science Monitor. Boston, Mass.: Dec 6, 1999. pg. 20.) hereafter Halverson.

Halverson does not consider the concept of instant transfer delivery. Accordingly, Halverson cannot not imply, suggest or otherwise make obvious "*... electronically providing an instant transfer delivery the declined portion of the unitized fund distribution to the receiving entity in a tax efficient manner . . .*" as claimed by amended base Claim 38. Claims 39-40 depend from base Claim 38 and thus inherit these claim limitations. Thus, the § 103 rejection of Claim 38-40 being unpatentable over Halverson is believed to be overcome. Acceptance is respectfully requested.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims (Claims 1-29 and 31-40) are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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